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In re Application of: FRANGIONE, Blas, et al.

U.S. Application No.: 10/540,294

PCT No.: PCT/US2003/040744

DECISION

International Filing Date: 18 December 2003

Priority Date: 19 December 2002

Attorney's Docket No.: 05986/100K560-US1

For: METHODS FOR TREATING AMYLOID
DISEASES

This decision is issued in response to: (1) the request for a refund of one half of the large entity basic national fee, filed 17 October 2005; (2) the "Response To Notification Of Missing Requirements" filed on 06 January 2006, treated in part herein as a petition under 37 CFR 1.181 to confirm the 17 October 2005 filing of an executed declaration and additional fees; and (3) the "Communication Affirming Correct Inventorship" filed 26 January 2006.

BACKGROUND

On 18 December 2003, applicants filed international application PCT/US2003/040744. The application claimed a priority date of 19 December 2002 and it designated the United States. The published international application listed three applicant-inventors for the United States: Blas FRANGIONE, Einar M. SIGURDSSON, and Jorge GHISO. The deadline for payment of the basic national fee was thirty months from the priority date, i.e., 20 June 2005 (19 June 2005 was a Sunday).

On 20 June 2005, applicants filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment of the large entity basic national fee.

On 17 October 2005, applicants filed a second submission that included, among other materials, an assertion of small entity status, a request for a refund of one half of the previously filed large entity basic national fee (considered below), \$280 in additional fees, and a declaration. The declaration was executed by the three inventors listed on the published international application, as well as an additional inventor, Thomas WISNIEWSKI.

On 08 November 2005, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 was required, as well as sequence listing materials and the search and examination fees.

On 06 January 2006, applicants filed the “Response To Notice Of Missing Requirements” considered in part herein, which included a copy of the declaration previously filed on 17 October 2005, an explanation regarding the previous fee payment, a copy of a return postcard itemizing the fee payment and declaration and bearing a USPTO receipt stamp dated 17 October 2005, and sequence listing materials responsive to the Notification Of Missing Requirements (including a purported Computer Readable Form (CRF) of the sequence listing).¹

On 26 January 2006, applicants filed the “Communication Affirming Correct Inventorship” considered herein. This submission seeks to confirm that the additional inventor listed on the declaration filed 17 October 2005 (i.e., Thomas WISNIEWSKI) is a proper inventor-of-record herein, despite the failure of the published international application to include his name.

DISCUSSION

1. Petition Under 37 CFR 1.181 To Confirm The 17 October 2005 Filing:

A review of the application file and applicants’ 06 January 2006 submission confirms that the executed declaration herein was filed on 17 October 2005, as was an additional fee payment of \$280 and the request for refund considered below.

2. Request For Refund:

Applicants’ 17 October 2005 submission included an assertion of small entity status and a request for a refund of one-half of the \$300 large-entity basic national fee filed on 20 June 2005 (based on the small entity status). However, pursuant to 37 CFR 1.28(a), any request for a refund of a portion of a previously paid large entity fee based on a later assertion of small entity status must be submitted within three months of the original fee payment. Because applicants’ refund request of 17 October 2005 was not filed within three months of the 20 June 2005 payment of the large entity basic national fee, a refund of any portion of such fee would be inappropriate.

Because applicants are not entitled to the refund of one half of the basic national fee, an additional \$150 in fees is required herein (\$100 as the small entity examination fee and \$50 as the small entity search fee). Based on the authorization contained in applicants’ 06 January 2006 submission, Deposit Account No. 04-0100 will be charged for these required fees.

3. Confirmation Of The Proper Inventors-Of-Record

The published international application listed only three applicant-inventors with respect

¹ It is noted that additional materials filed by above counsel on 06 January 2006 with respect to an unrelated application, including fees in the amount of \$2,130, were inadvertently placed in the present application file. These materials and fees will be forwarded to the application file to which they were intended (11/267,027).

to the United States. However, a review of the USPTO application file for the international application and communications with the International Bureau have confirmed that there are four applicant-inventors of record for the instant application: Blas FRANGIONE, Einar M. SIGURDSSON, Thomas WISNIEWSKI, and Jorge GHISO.

Accordingly, the declaration filed herein by applicants on 17 October 2005, which identifies and is executed by these four applicant-inventors, properly identifies the applicants-of-record, as required.

CONCLUSION

The petition under 37 CFR 1.181 to confirm the 17 October 2005 filing of the executed declaration, additional fees, and refund request is **GRANTED**.

The request for a refund of one half of the large entity basic national fee is **DISMISSED** without prejudice pursuant to 37 CFR 1.28(a). Any request for reconsideration of the decision on the refund request must be submitted within **TWO MONTHS** of the mail-date of the present decision.

Deposit Account No. 04-0100 will be charged \$100 as the small entity examination fee and \$50 as the small entity search fee.

The request to confirm that Thomas WISNIEWSKI is an inventor-of-record is **GRANTED**. The inventors-of-record herein are Blas FRANGIONE, Einar M. SIGURDSSON, Thomas WISNIEWSKI, and Jorge GHISO, as listed on the declaration filed by applicants on 17 October 2005.

This application is being forwarded to the National Stage Processing Branch of the Office Of PCT Operations for further processing in accord with this decision, including a review of applicants' 06 January 2006 submission of sequence listing materials.



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